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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,105	07/08/1999	CHRISTINE RONDEAU	05725.0441-0	6226

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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 07/14/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/349,105

Applicant(s)

RONDEAU, CHRISTINE

Examiner

Margaret Einsmann

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-6 and 8-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-6 and 8-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

This action is in response to the request for reconsideration filed 4/5/2002.

The provisional obviousness double patenting rejections over claims of applications 09/350,579, 09/287,176, 09/349,436 withdrawn in view of the terminal disclaimer which was in proper form and was entered into this application.

Claim Rejections - 35 USC § 102

The rejection of 1-6, 10-17, 25-29, 32-34, 38-47 rejected under 35 U.S.C. 102(e) as being anticipated by Rondeau, US 6001,135 is withdrawn due to the amendment adding the limitation of claim 7 into claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rondeau, US 6,001,135.

This rejection is maintained for the reasons set forth in the office action of 9/13/2000. Applicant argues that there is too much picking and choosing to do in order to substitute a gum, starch or other sugar containing polymer from those in column 23

lines 24-31. However, there are only three choices given in the paragraph listing the organic excipients in the composition: (1) synthetic polymers, (2) polysaccharides [Note: all of these contain sugar units- the term means a plurality of sugar units] and (3) natural products [Note: all of those listed comprise sugar units]. Thus, not only does applicant teach the equivalence of the above three organic polymeric groups for addition to the composition, but most of those listed contain sugar units, thus reading on applicant's thickening polymer. Applicant states that there is no motivation to substitute another sugar containing polymer for the sawdust of example 2. All disclosures of the prior art, including non-preferred embodiment, must be considered. See *In re Lamberti and Konort*, 192 USPQ 278 (CCPA 1967); *In re Snow* 176 USPQ 328 (CCPA 9173) All of the disclosures in a reference must be evaluated for what they fairly teach to one of ordinary skill in the art. *In re Smith*, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; *In re Nehrenberg*, CCPA 1159, 280 F. 2d 161, 126 USPQ 383. Note M.P.E P. 2123, "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. *In re Heck*, 699 E.2d 1331, 1332-1333, 216 USPQ 1038, 1039 (Fed Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.) cert. denied, 493 U. S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or

nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Applicant further states that there is no motivation to substitute any other polymer from the list in col 23 for the sawdust in example 2. There is no motivation needed to substitute equivalents as long as the prior art recognizes the equivalence. Such equivalence is taught at column 23 lines 24-31.

Applicant argues in the response filed 9/6/2001 that "organic pulverulent excipients" are not the equivalent of "thickening polymers". They are equivalent when they are defined as being composed of the same polymer. Applicant argues that a thickening polymer cannot be equated with a pulverulent expedient. If applicant is inferring that the polymer comprising at least one sugar unit claimed cannot be in the form of a powder, the examiner finds no basis or limitation as to the form of the polymeric additive. Rondeau clearly lists polysaccharides such as celluloses and modified or unmodified starches as well as "...guar gums" as equivalent additives in the inventive compositions.

Applicant argues that if all of the organic excipients are equivalent of applicant's thickening polymers, then the organic excipients must be equivalent to the inorganic excipients. Applicant states that this reasoning is clearly invalid. However, it is applicant's reasoning that is invalid. This office did not equate titanium dioxide to sawdust, applicant did. The reference at col 23 lines 24-31 refers to the organic excipient which is selected from sugar containing polymers of the group of polysaccharides.

Applicant states, beginning at the bottom of page 8, that Rondeau requires at least one oxidation base and at least one oxidizing agent, neither of which are required by broad claim 1. Applicant certainly knows that neither is excluded from claim 1 which is an open claim. Evidence that neither is excluded is dependent claims 30-40 which makes it apparent that applicant intends to include compositions comprising oxidation bases and oxidizing agents. Accordingly, applicant does not have to remove the two components. As for the motivation to add the thickening polymer, Rondeau teaches the addition of sugar containing polymers at the places cited in the disclosure.

Claims 1-6, 8-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Oreal, FR 2,757,388. This reference is the equivalent of Rondeau 6,001,135 and accordingly the rejection is applied as in the above rejection. In this case the 103(a) rejection is based on a reference that qualifies as prior art under 35 USC 102 (b) as being published more than one year before the US filing date of the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7,8,18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are dependent on canceled claim 7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret Einsmann
Primary Examiner
Art Unit 1751

July 8, 2003